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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,303	01/30/2002	Norman Yamamoto	310048-681	2023
7590	06/07/2004		EXAMINER	
Douglas N. Larson, Esq. SQUIRE, SANDERS & DEMPSEY L.L.P. 801 S. Figueroa St., 14th Floor Los Angeles, CA 90017-5554			COLILLA, DANIEL JAMES	
			ART UNIT	PAPER NUMBER
			2854	

DATE MAILED: 06/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n No.

10/066,303

Applicant(s)

YAMAMOTO ET AL.

Examiner

Dan Colilla

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 March 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4,11,52,57,58,66 and 78-194 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 57,58,78-168 and 188-194 is/are allowed.
- 6) ☒ Claim(s) 4,11,52,66,169-179,181,183,184 and 186 is/are rejected.
- 7) ☒ Claim(s) 180,182,185 and 187 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claims 175 and 190 are objected to because of the following informalities:

In claim 175, applicant is attempting to define his invention by citing limitations of a document. However, since the document is not part of the claimed subject matter (it is mentioned in a statement of intended use) this is inappropriate since the document the assembly is used with could be of any desirable size and may be used with documents of different sizes. Appropriate correction is required.

In claim 190, line 8, it appears that "second" should actually be --first-- for the claim to make sense.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

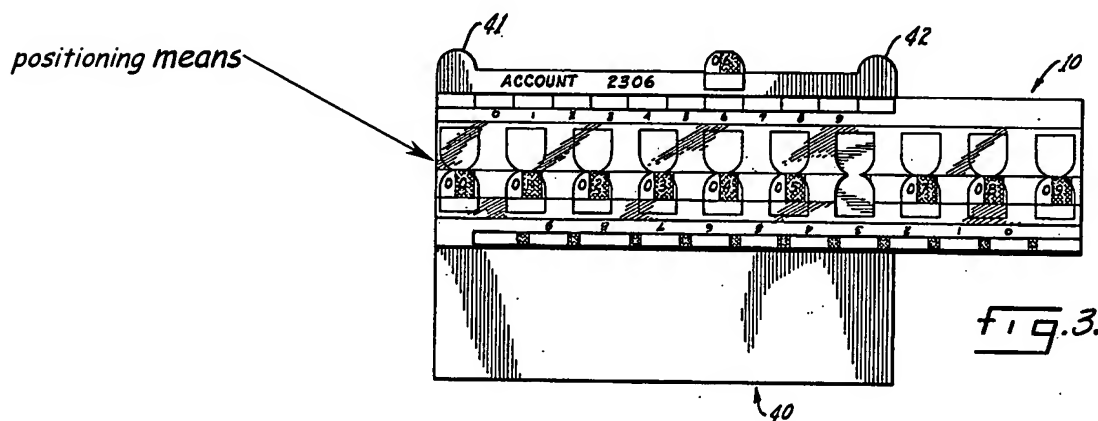
3. Claims 11, 52 and 169-175 are rejected under 35 U.S.C. 102(b) as being anticipated by Glowiak.

With respect to claim 11, Glowiak discloses an assembly 10 which includes a releasably attachable alignment tool 12 and indicia 23 on the tool for indicating tab positions as shown in Figures 1-2 of Glowiak. Glowiak further discloses in col. 3, lines 1-5, that adhesive 13 can be on the back of tool 12.

Art Unit: 2854

With respect to claim 52, Glowiak discloses a customizable indexing system including at least one releasably (Glowiak, col. 3, lines 1-16) attachable alignment tool 23, a plurality of indicia on the alignment tool 23 as shown in Figure 1 of Glowiak, and an indexing material 40 as shown in Figure 3 of Glowiak. Further disclosed is an adhesive on a back side of the tool 12 (col. 2, lines 71-72 and col. 3, lines 1-5).

With respect to claim 169, Glowiak discloses an alignment tool 12 with a left edge that positions the tool 12 so that it is aligned with the edge of a card 40 (indexing document) as shown below in the Figure taken from Glowiak:



The tool 23 can be used for aligning tabs on a set of cards as shown in Figure 4 of Glowiak. Additionally, Glowiak discloses indicia 23 on the tool for indicating tab positions as shown in Figures 1-2 of Glowiak.

With respect to claim 170, Glowiak discloses that adhesive 13 can be on the back of tool 12. All adhesives are releasable in one manner or another.

Art Unit: 2854

With respect to claim 171, Glowiak discloses indicia 23 that includes a numbering system as shown in Figure 1 and mentioned in col. 4, lines 4-14 of Glowiak.

With respect to claim 172, the numbering system includes a plurality of sequential numbers as shown in Figure 3 of Glowiak.

With respect to claim 173, the numbers on one side of the tool 12 are separated from each other by the same distance.

With respect to claim 174, the tool 12 disclosed by Glowiak is color coded as mentioned in col. 7, lines 16-22.

With respect to claim 175, It would have been obvious to make the tool the same length as a document length in order to be able to use the tool for placing tabs along the whole length of the document. If the tool is intended to be used with a standard size document it would also have been obvious to make the tool the exact same length as a document size in order not to waste additional materials on the tool when it will not be needed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4, 179, 181, 184 and 186 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glowiak in view of Cook.

With respect to claim 4, Glowiak discloses the claimed assembly except for the numerals positioned in a staggered manner. Glowiak discloses an assembly 10 which includes a releasably attachable alignment tool 12 and indicia 23 on the tool for indicating tab positions, as shown in Figures 1-2, and indicia 23 that includes a numbering system as shown in Figure 1 and mentioned in col. 4, lines 4-14 of Glowiak. Further disclosed by Glowiak is a plurality of vertical lines and a plurality of horizontal lines in the indicia. Cook teaches a measure that includes a plurality of numbers positioned at the end of horizontal staggered lines as shown in Figure 5 of Cook. It would have been obvious to combine the teaching of Cook with the assembly disclosed by Glowiak for the advantage of easier viewing of the increments of measurement on the tool.

With respect to claims 179 and 184, Glowiak discloses the claimed assembly except for the second set of indicia have different symbols. Cook however, teaches first and second sets of indicia with different symbols as shown in Figure 3 on the left and right sides of the measuring tape. It would have been obvious to combine the teaching of Cook with the assembly disclosed by Glowiak for the advantage of providing separate measuring systems giving the user a choice of system to measure with.

With respect to claims 181 and 186, Cook teaches indicia, on the right side of the measuring tape, having a set of lines with a short length and, on the left side of the measuring tape, a set of lines with a longer length as shown in Figure 3 of Cook.

6. Claim 66 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glowiak in view of Pederson and Ericson.

Art Unit: 2854

Glowiak discloses the claimed assembly except for the computer program and the package. However, Pederson teaches that it is known to print measurement scales using software and a printer as mentioned on page 3, paragraph 54 of Pederson. It would have been obvious to combine the teaching of Pederson with the assembly disclosed by Glowiak for the advantage of printing automation provided by a printer. Ericson teaches a packaging assembly 101 for holding an alignment tool 14, tabs 47 and indexing material 11 and 12 as shown in Figures 8-10 of Ericson. It would have been obvious to combine the teaching of Ericson with the assembly disclosed by Glowiak in view of Pederson for the advantage of holding all the parts of a kit together.

7. Claim 176 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glowiak as in view of Ondiviela.

Glowiak discloses the claimed assembly except for the flap. However, Ondiviela teaches an assembly for aligning tabs including a flap as shown in Figures 3a,3b and 4a of Ondiviela. It would have been obvious to combine the teaching of Ondiviela with the assembly disclosed by Glowiak for the advantage of aligning the tabs so that they are square with the top edge of the sheet to which the tabs are being applied.

8. Claim 177 is rejected under 35 U.S.C. 103(a) as being unpatentable over Glowiak in view of Hasegawa.

Glowiak discloses the claimed assembly except for the exposed adhesive strip. However, Hasegawa teaches an assembly including adhesive strips 2 set inwardly from both side edges

Art Unit: 2854

thereof as shown in Figure 4 of Hasegawa. It would have been obvious to combine the teaching of Hasegawa with the assembly disclosed by Glowiak for the advantage of being able to fold the tool over onto itself thus removing the need of a backing sheet to protect the adhesive. There is also an advantage of saving adhesive costs by not coating the entire back of the assembly with adhesive.

9. Claims 178 and 183 are rejected under 35 U.S.C. 103(a) as being unpatentable over Glowiak.

With respect to claim 178, Glowiak discloses the claimed assembly except for the first and second set of indexing documents. *It is noted here that applicant has not actually positively claimed the indexing documents as part of the claimed assembly. However, the function of positioning means has been further limited in terms of the indexing documents thus requiring them to be part of the invention.* Glowiak discloses a first set of indicia 23 and a second set of indicia 24 with different spacing as shown in Figure 1 of Glowiak. While it is not known to the examiner if these sets of indicia are used with different sets of indexing documents, since it is known to use the tool 12 with one set of indexing documents, it would have been obvious to use it for more than one set of indexing documents. One of ordinary skill in the art would see that using the same structure for carrying out the same function for a plurality of times would have been obvious. Additionally, one of ordinary skill in the art would recognize that not all sets of indexing documents will have the same number of indexing documents since subject matter that is indexed is extremely variant and depends on the nature of the subject matter.

With respect to claim 183, Glowiak discloses the claimed assembly except for the first and second set of indexing documents. Glowiak discloses a first set of indicia 23 with a first set of spaced index tab affixation positions and a second set of indicia 24 with differently spaced second set of spaced index tab affixation positions as shown in Figure 1 of Glowiak. While it is not known to the examiner if these sets of indicia are used with different sets of indexing documents, since it is known to use the tool 12 with one set of indexing documents, it would have been obvious to use it for more than one set of indexing documents. One of ordinary skill in the art would see that using the same structure for carrying out the same function for a plurality of times would have been obvious. Additionally, one of ordinary skill in the art would recognize that not all sets of indexing documents will have the same number of indexing documents since subject matter that is indexed is extremely variant and depends on the nature of the subject matter.

Allowable Subject Matter

10. Claims 57-58, 78-168 and 188-194 are allowed.
11. Claims 180, 182, 185 and 187 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
12. The following is a statement of reasons for the indication of allowable subject matter:

Art Unit: 2854

Claims 180 and 185 has been indicated as containing allowable subject matter primarily for the first and second sets of symbols being the number of documents in the first and second set of documents respectively.

Claims 182 and 187 has been indicated as containing allowable subject matter primarily for the first and second sets of indicia having first and second colors respectively.

Claims 188-189 have been allowed primarily for the sheet having a plurality of index divider alignment tools and the weakened separation lines.

Claims 190-193 have been allowed primarily for the sheet having a plurality of index divider alignment tools and the indicia means thereon.

Claim 194 has been allowed primarily for the indexing sheet having indicia means for identifying index tab affixation positions at different positions along the first edge when the second edge is position on the first side.

Response to Arguments

13. Applicant's arguments filed 3/15/04 have been fully considered but they are not persuasive of any error in the above rejection.

With respect to claim 4, Cook is relied upon to teach numbers at the ends of horizontal lines that are staggered relative to one another.

With respect to claims 11 and 52, any adhesive can be considered releasable when it is removed from the surface that it has been applied. The language, "releasably attachable to a document to align index tabs" in claim 11 is a method of intended use and does not imply any

Art Unit: 2854

further structure in the claim. Furthermore, Glowiak discloses that the pressure sensitive adhesive is separated from adherence by a pulling force (Glowiak, col. 3, lines 13-15).

With respect to claim 66, applicant has not pointed out in any detail how the combination fails to disclose the claimed subject matter. Thus this response can do nothing but reject the claim as outlined above. The prior art does appear to disclose the claimed subject matter.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Colilla whose telephone number is (571)272-2157. The examiner can normally be reached Mon.-Thur. between 7:30 am and 6:00 pm. Faxes regarding this application can be sent to (703)872 - 9306.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached at (571)272-2168. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

Art Unit: 2854

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

May 28, 2004

A handwritten signature in black ink, appearing to read "Daniel J. Colilla", is positioned above the printed name.

Daniel J. Colilla
Primary Examiner
Art Unit 2854